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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,642	07/27/2001	Tim Corvi	018489001610	9072

20350 7590 10/19/2005

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EXAMINER

FOREMAN, JONATHAN M

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/916,642

Applicant(s)

CORVI ET AL.

Examiner

Jonathan ML Foreman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 May 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 62-81 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 62-81 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/5/04.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statement filed 8/5/04 complies with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. It has been placed in the application file, and the information referred to therein has been considered by the examiner as to the merits. However, US Patent No. 4,986,807 to Farr has already been made of record.

### ***Specification***

1. The disclosure is objected to because of the following informalities: Page 1, before line 5 includes an improper incorporation by reference. An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (see 35 U.S.C. 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. 120 after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. 120 is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. See *Dart Indus. v. Banner*, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an

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application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 62, 65, 66, 68, 69, 71, 72, 75, 76, 78, 79 and 81 are rejected under 35 U.S.C. 102(b) as being anticipated by US 3,831,585 to Brondy et al.

In regards to claims 62, 65, 66, 68, 69, 71, 72, 75, 76, 78, 79 and 81, Brondy et al. discloses a catheter body (40) having a proximal portion, a distal portion and a longitudinal axis; a cutting window (42) disposed on the distal portion of the catheter body; an axially movable material capture device (44, 45) that moves between a first axial position in which the material capture device is disposed within the catheter body, and a second axial position in which the material capture device extends outwardly from the cutting window and directs material from the body lumen into the cutting window (Col. 4, lines 40 – 44). The material capture device comprises a sharpened edge that penetrates into the material (Col. 4, lines 25 – 27; lines 40 – 44). The first axial position is distal to the second axial position (Col. 4, lines 38 – 44). A drive wire (12) is coupled to the material capture device to facilitate movement between the first position and the second position. The catheter includes an atraumatic distal tip (Col. 4, lines 33 – 35).

4. Claims 62, 64 – 69, 72 and 73 - 79 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,224,488 to Neuffer.

In regards to claims 62, 64 – 69, 72 and 73 - 79, Neuffer discloses a catheter body (14) having a proximal portion, a distal portion and a longitudinal axis; a cutting window (28) disposed on the distal portion of the catheter body; an axially movable material capture device (30) that moves between a first axial position in which the material capture device is disposed within the catheter body, and a second axial position in which the material capture device extends outwardly from the cutting window and directs material from the body lumen into the cutting window (Col. 3, lines 40 – 47). A cam surface is disposed in the distal portion of the catheter body (Col. 3, lines 36 – 39) in

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that the capture device must push against the catheter body in order to extend out of the cutting window. The material capture device is rotatable (Col. 3, lines 55 – 57) and comprises a sharpened edge that penetrates into the material. A drive wire is coupled to the material capture device to facilitate movement between the first position and the second position (Col. 3, lines 44 – 47). The material capture device comprises a curved surface adjacent the sharpened edge (Figure 3). The material capture device includes a first axial position which closes the window in that the material capture device moves from within the catheter body to the outside of the catheter body through the window.

5. Claims 62, 65 – 67, 69, 71, 72, 75 – 77, 79 and 81 are rejected under 35 U.S.C. 102(e) as being anticipated by US 5,823,971 to Robinson et al.

In regards to claims 62, 65 – 67, 69, 71, 72, 75 – 77, 79 and 81, Robinson et al. discloses a catheter body (50) having a proximal portion, a distal portion and a longitudinal axis; a cutting window (52) disposed on the distal portion of the catheter body; an axially movable material capture device (Col. 5, line 50) that moves between a first axial position in which the material capture device is disposed within the catheter body (Figure 4b), and a second axial position in which the material capture device extends outwardly from the cutting window (Figure 4a) and directs material from the body lumen into the cutting window. The material capture device comprises a sharpened edge that penetrates into the material and a curved surface adjacent the sharpened edge (Figure 4; Col. 5, line 50). A drive wire (54) is coupled to the material capture device to facilitate movement between the first position and the second position. The catheter includes an atraumatic distal tip (Figure 4).

#### ***Response to Arguments***

6. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
JMLF

  
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